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James R. Robellard

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CASTELLANO, STEPHEN J

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/758,626
Filing Date: January 15, 2004
Appellant(s): ROBELLARD ET AL.

Matthew W. Adams
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 11, 2008 appealing from the Office action mailed February 13, 2008.

Art Unit: 3781

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

Art Unit: 3781

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Patents:

D524,501	PROKOP et al.	7-2006
D524,003	PROKOP et al.	6-2006
5, 992,106	CARLING et al.	11-1999
5,314,061	BEDROSSIAN	5-1994
4,107,815	DUMESNIL, Jr.	8-1978
3,825,970	HANSSEN	7-1974

Publications:

2003/0074760	KELLER	4-2003
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Art Unit: 3781

Official Notice and Prior Art Admissions:

Official Notice was taken that protrusions on the container body for reinforcing and attaching a bail handle are well known in the non-final Office action mailed July 31, 2007. This Official Notice was treated as a prior art admission in the Final Office action mailed February 13, 2008. The prior art admission is being maintained in the appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Item A:

Claims 30, 32, 38 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Hanssen.

Hanssen discloses a paint roller, frame and shield. When the shield is placed in a position to paint a ceiling, the shield defines an open top container body made of one-piece as the elongated handle can be removed. The container body has a sloped floor of arcuate shape and a pair of opposing sidewalls, the sloped floor and sidewalls define an elongated reservoir for holding liquid (paint). The roller includes an elongated cylinder having two circular end portions which attach the cylinder to the opposed sidewalls, the inside surface of the elongated cylinder has a first roller surface (a small longitudinal strip of the inside surface of cylinder) pivotally coupled to the container body in a first position (the position where the first surface lies closest to bolt 18), located within the reservoir at a level above the volume of liquid (which liquid is comparatively shallow in depth) and below the open top, and is further positioned about 70

Art Unit: 3781

degrees to about 110 degrees from vertical (the strip covers an arc of less than 40 degrees of the 360 degree inner circumference).

Re claims 30 and 38 which both recite “a first roller surface for distributing liquid over a roller-type liquid applicator,” this amendment doesn’t define over the rejection. Firstly, appellant admits that this amendment does not narrow the claims in the remarks submitted November 30, 2007 on page 8, second to last paragraph, first two sentences. Secondly, the amendment contains an intended use limitation which functionally recites that the first roller surface is for distributing liquid. The inside surface 35 as shown in Fig. 2 of Hanssen is a partially cylindrical and concave surface. A small roller of a width smaller than the inner circumference of surface 35 and shorter in length than the roller 34 would fit within the roller 34 with the roller end caps and the shield assembled. Paint within the roller inner cavity bound by the inner surface 35 and the end caps would be applied to the small roller through the rolling action of the roller 34 within its shield. With the assistance of gravity, the small roller placed inside roller 34 will roll to the lowest position inside roller 34 as roller 34 rotates transferring paint around the entire circumference of the small inner roller. For this reason, the inner surface 35 is inherently capable of distributing liquid over a roller-type liquid applicator.

Re claim 38, the first roller surface faces upward and the roller defines an access zone that allows accessing liquid by a roller type applicator.

Re claim 40, the strip covers an arc of less than 20 degrees of the 360 degree inner circumference.

Art Unit: 3781

Item B:

Claims 30, 32 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Dumesnil, Jr. (Dumesnil).

Dumesnil discloses a one-piece container body (paint tray) defining an open top reservoir for holding a designated volume of liquid and a first roller surface (part of the outer surface of the transfer roller 14 positioned to face downwardly towards a surface of paint in the reservoir) pivotally coupled to the container body, the first roller surface (part of outer surface of transfer roller 14) is located within the reservoir at a level above the volume of liquid and below the open top and is further positioned about 70 to 110 degrees from the vertical (the portion of the outer surface of transfer roller 14 is less than 40 degrees of the 360 degree inner circumference).

Re claim 30 which recites “a first roller surface for distributing liquid over a roller-type liquid applicator,” this amendment doesn’t define over the rejection. Firstly, appellant admits that this amendment does not narrow the claims in the remarks submitted November 30, 2007 on page 8, second to last paragraph, first two sentences. Secondly, the amendment contains an intended use limitation which functionally recites that the first roller surface is for distributing liquid. The outer surface of transfer roller 14 is inherently capable of distributing liquid over a roller-type liquid applicator when a roller applicator is positioned to contact the outer surface of the transfer roller 14 and a rolling motion is imparted to the transfer roller 14 such that the transfer roller moves within paint to transfer the paint from the paint tray to the transfer roller, Simultaneously, the roller applicator positioned in contact with the transfer roller 14 is moved in a rolling motion by the rolling motion of the transfer roller 14 and the paint on the transfer roller 14 is transferred to the roller applicator.

Art Unit: 3781

Item C:

Claims 33 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dumesnil in view of Bedrossian.

Re claim 33, Dumesnil discloses the invention except for the lid. Bedrossian teaches a lid to cover a paint receptacle. It would have been obvious to cover the paint receptacle to keep contaminants from soiling paint in the tray or to preserve the freshness of the paint by keeping it from drying out.

The seal formed by the lid of Bedrossian is best shown in Fig. 5 and is described in col. 3, lines 56-58 of Bedrossian as having a snap retention. There is no indication from the claim language that the seal must extend around the entire circumference or be watertight. The lid is operable to seal the open top.

Re claim 38, Dumesnil discloses the invention except for paint tray having a depth deep enough to immerse the roller below the upper edge of the tray. Bedrossian teaches a paint bucket having a substantial depth. It would have been obvious to provide a greater depth for the paint tray of Bedrossian to provide a first roller surface that faces upwardly and away from the floor such that the first roller surface is located within the reservoir above the designated liquid, spans between the pair of opposing side walls and defines an access zone for accessing liquid in the container by the roller-type applicator.

Art Unit: 3781

Item D:

Claims 1-7, 10, 12-16, 18, 26-27, 29 and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dumesnil in view of Bedrossian and Keller.

Dumesnil discloses the invention except for the lid and the roller perforations.

Bedrossian teaches a lid to cover a paint receptacle. It would have been obvious to cover the paint receptacle to keep contaminants from soiling paint in the tray or to preserve the freshness of the paint by keeping it from drying out. Keller teaches a roller cover of either open cell foam or sponge material suitable materials capable of carrying paint (see paragraph [0029]. lines 1-6). The foam and sponge materials are perforated. It would have been obvious to modify the roller to be covered by a perforated material roller cover so that the first roller surface becomes the outer perforated surface of the roller cover to (1) protect the roller, (2) increase absorption properties of the roller and (3) allow for easy replacement of the roller cover when the roller cover first surface becomes worn.

Re claims 16-18, Bedrossian further teaches a handle. It would have been obvious to add a handle for easy carrying by a convenient and comfortable grip. Official notice was taken that protrusions on the container body for reinforcing and attaching a bail handle are well known in the non-final Office action mailed July 31, 2007. The Official notice is now being treated as a prior art admission. It would have been obvious to add the protrusions to reinforce the body at the area of bail handle attachment to prevent a rip or prevent excessive wear from occurring at the handle attachment site.

Art Unit: 3781

Item E:

Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dumesnil in view of Bedrossian and Keller as applied to claim 1 above, and further in view of Carling et al. (Carling).

The Dumesnil-Bedrossian-Keller combination discloses the invention except for the X shaped support structure where a first rib approaches a second rib proximate the center of the body. Carling teaches the X shaped support structure supporting a generally planar surface as shown in Fig. 3. It would have been obvious to use the X shaped pattern for the first roller surface to provide reinforcement.

Item F:

Claims 1-7, 10, 12-16, 18, 21-22, 26, 27, 29, 30, 32, 33, 36-38 and 40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims (the drawings) of U.S. Patent No. D524501 to Prokop et al. (Prokop) in view of Bedrossian. Prokop discloses the invention except for the lid. Bedrossian teaches a lid to cover a paint receptacle. It would have been obvious to cover the paint receptacle to keep contaminants from soiling paint in the tray or to preserve the freshness of the paint by keeping it from drying out.

Item G:

Claims 1-7, 10, 12-16, 18, 21-22, 26, 27, 29, 30, 32, 33, 36-38 and 40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims (the drawings) of U.S. Patent No. D524003 to Prokop et al. (Prokop) in view of Bedrossian.

Art Unit: 3781

Prokop discloses the invention except for the lid. Bedrossian teaches a lid to cover a paint receptacle. It would have been obvious to cover the paint receptacle to keep contaminants from soiling paint in the tray or to preserve the freshness of the paint by keeping it from drying out.

(10) Response to Argument

As pointed out with particularity in Items A and B, appellant has admitted on the record that the amendment: “first roller surface for distributing liquid over a roller-type liquid applicator” as added to claims 30 and 38 in the November 30, 2007 amendment doesn’t narrow the claims. Appellant stated that “this amendment is not narrowing.” (see page 8, first two sentences of the second to last paragraph of appellant’s remarks submitted November 30, 2007). This admission seems to affect the interpretation of claims 30, 32, 33, 38 and 40 such that the intended use limitation (“for distributing liquid over a roller-type liquid applicator”) should be ignored in these claims. Up to this point in the prosecution, appellant has not made an attempt to withdraw his statement or redact this admission.

Appellant’s response to this admission is that the examiner has taken some form of inappropriate or improper action or inaction and that the examiner fails to address the limitation. Despite appellant’s position that the intended use limitation (amendment) is not narrowing, the examiner treats this intended use limitation and all limitations of the claims.

Item A: Hanssen

Claim 30 has a first roller surface. The surface is broadly claimed. Appellant has a preconceived notion of a “roller surface.” The surface must be located on an exterior surface and

Art Unit: 3781

it must be exposed to the paint within the container body. However, these notions of the roller surface are not claimed.

The first roller surface in Hanssen is identified as the inner surface 35 of the roller 34 as shown in Fig. 2. The intended use limitation “for distributing liquid over a roller-type liquid applicator” does not define the first roller surface as an outer surface of the roller 34.

Although Hanssen sets forth a method of using wherein paint is applied to the outer surface of the roller 34, this doesn't preclude that Hanssen's device can be used in an alternate fashion. The Hanssen rejection gives details of one such alternate method wherein the inner surface of the roller 34 is used to apply paint to a roller applicator of smaller dimension that fits within the inner boundary of the roller 34. The inner surface of roller 34 of Hanssen can be used for distributing liquid over a roller applicator and defines an access zone within the inner boundary of the roller 34 for accessing liquid in the container by the roller applicator.

Item B: Dumesnil

Dumesnil states particular use for pads. There is no disclosure that Dumesnil can't be used for roller applicators. Appellant hasn't set forth any reason why the Dumesnil device can't be used with a roller applicator. However, Dumesnil does not explicit teach use with roller applicators.

Appellant is incorrect in stating that the examiner is basing the anticipation rejection on an inherent teaching. All the structural elements are shown by Dumesnil. The limitation in question is a functional limitation or an intended use limitation: “for distributing liquid over a roller-type liquid applicator.” The Dumesnil device is fully capable of use with a roller

Art Unit: 3781

applicator for distributing liquid over the applicator's surface. In the statement of the rejection, the examiner has explained that a roller applicator brought into direct contact with the transfer roller will allow rolling movement of both the transfer roller and the roller applicator so that paint transfers first from the paint tray to the transfer roller then from the transfer roller to the roller applicator.

Item C: Dumesnil in view of Bedrossian

Re claim 33, appellant rebuts that the Bedrossian removable lid is operable to seal the open top of Dumesnil because the hooked shaped brackets or clips 30, 32 would interfere with the lid's fit. The clips 30, 32 are only located along a single side of the paint tray. Bedrossian teaches a lid which tightly fits the open top as shown in Fig. 5, the plurality of tabs 44 are disposed about the locking channel 41 for snap retention with the peripheral ledge 42 of the container body as stated in col. 3, lines 56-58 of Bedrossian. The type of seal is not specified to be watertight. The circumferential extent of the seal is not specified to be completely around the entire circumference of the open top. For this reasoning, the lid of Bedrossian applied to the open top of Dumesnil will tightly seal along three of the four sides and is operable to seal the open top.

Re claim 38, appellant rehashes arguments made in Item B in rebutting the Dumesnil rejection. No new arguments are provided.

Art Unit: 3781

Item D:

No argument is presented under this heading. Appellant remarks mostly about Keller under the Item E heading and it is believed that appellant chooses to rebut this rejection under the heading for Item E.

Item D and E:

Appellant rehashes arguments made in Item B in rebutting the Dumesnil rejection. In rebutting the combination with Keller, it is stated that there is no clear articulation why would such a modification “protect the roller” or “increase absorption?” Motivation to protect the roller is useful to prevent the roller from being damaged, leading to longer roller life, less replacement, less cost, monetary and time savings. Motivation to increase roller absorption is useful in making painting more efficient, the roller holds a greater quantity of paint, the user saves time by dipping the roller less often, the more absorption would allow the paint to be applied more evenly in less time making the painting work move quicker. Also, less drips and splatter from the roller, leading to savings in clean-up of drips and savings in the paint material which is usually discarded once dripped or splattered.

There is no rebuttal of the combination of Carling.

Item F:

No argument is presented under this heading. Appellant remarks pertaining to the obvious-type double patenting rejections seem to apply equally to both double patenting references.

Item F and G: Obvious-Type Double Patenting

Appellant is adamant in stating that two-way obviousness is required for this design-utility situation. The case law cited in support of appellant's position: *Carman Indus.* and *In re Dembiczak* are case specific situations where two-way obviousness was deemed appropriate for a design-utility situation. The present case is deemed substantially different from these two cases. As far as obvious-type double patenting is concerned, the same criteria is applied for design-utility situations as for utility-utility situations (i.e. one-way obviousness is the norm). One-way obviousness is the criteria that should be applied in the present situation.

The present case deals with limitations pertaining to the internal structure of a paint container, e.g. the first roller surface is an internal part. Both design references disclose the external appearance as well as the internal appearance and the internal structure. Cross sectional views are used to represent the design and disclose the internal structure. Other Obvious-type double patenting cases (e.g., *Carman Indus.* or *In re Dembiczak*) may have a different fact situation wherein the internal structure is claimed in a utility application but the applied design patent(s) only disclose external appearance.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Art Unit: 3781

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Stephen J. Castellano/

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TQAS, TC 3700